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Donald J. Ersler			HAUGLAND, SCOTT J	
725 Garvens Avenue				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER W. UTECHT and DANIEL M. OLSON

Appeal 2008-1556
Application 10/084,691
Application Technology Center 3600

Decided: September 26, 2008

Before HUBERT C. LORIN, LINDA E. HORNER, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 20-22, 24-29, 31-35, and 37-39. Claims 1-19, 23, 30, and 36 have been canceled.

We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

Appellants claim a hydraulic reel for pipeline cleaning for attachment to a skid steer which is said to position the reel in close proximity to a pipeline access. (Specification 1:4-9.)

Claim 20, reproduced below, is representative of the subject matter on appeal.

20. A method of transporting a length of hose to an area only wide enough to allow passage of a skid steer, comprising the steps of:
 providing a skid steer having a mounting member;
 attaching a base frame to said mounting member;
 attaching a reel frame to said base frame;
 retaining pivotally a hose reel in said reel frame, winding a length of hose on said hydraulic reel; and
 rotating said hose reel with a hydraulic motor, supplying said hydraulic motor with hydraulic oil from said skid steer.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Egerstrom	US 4,066,093	Jan. 3, 1978
Cochran	US 4,545,720	Oct. 8, 1985

The following rejection is before us for review.

1. Claims 20-22, 24-29, 31-35, and 37-39 stand rejected under 35 U.S.C. § 103(a) over Cochran in view of Egerstrom.

ISSUE

The sole issue before us is whether Appellants have sustained their burden of showing that the Examiner erred in rejecting the claims on appeal as being unpatentable under 35 U.S.C. § 103(a) over Cochran in view of Egerstrom.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Examiner found

Cochran et al discloses a skid steer vehicle having a quick release mounting member 10 for detachably connecting a base frame (of 18) to the vehicle. The base frame is provided with top retention plates 20, lower slotted retention plates 24, and locking pins 38.

Cochran does not disclose providing a skid steer vehicle with a hose reel.

Egerstrom teaches providing a vehicle with a hydraulic reel comprising a base frame 18,20, a reel base 76 including upright members 84, a reel 28 holding a length of hose 44, and a hydraulic motor 62. The reel 28 is supported by a hollow axle 38 having a hose outlet (portion of hose 44 between axle 38 and jointing means 50). The reel has an opening 46 through which the hose passes for connection to the hose outlet. See Fig. 2. One end of the axle is sealed. A rotary union 60 attached to the other end. A pair of bearings (see claim 3 of Egerstrom) supports the axle on the reel base. The apparatus includes hose guide 120 one

end of which extends from the reel base. A pulley 148 is mounted on the other end.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Cochran et al with a base frame mountable to the quick release mounting having a hose reel and hose guiding apparatus as taught by Egerstrom to permit the transport of a hose reel using the skid steer vehicle of Cochran et al in addition to the other handling devices which the vehicle of Cochran et al is capable of transporting, thus permitting the hose reel to be carried over terrain more suited to the use of a skid steer vehicle. It would have been further obvious to drive the hydraulic motor with hydraulic oil from the skid steer vehicle to eliminate the need for a duplicate pump.

(Final Rej. 2-3.)

2. Egerstrom discloses a cradle 32 supporting a reel or hose drum 28 for hose storage (Egerstrom, col. 2, ll. 14-17), which cradle 32 has a base plate 76 which rests on a turntable 86 against the platform of the truck (Egerstrom, col. 3, ll. 5-8).

3. Cochran discloses that “[i]t is an object of this invention to provide a quick coupling assembly for easily coupling and releasing different buckets to the same front end loader lift arms.” (Cochran, col. 1, ll. 18-21.)

4. Cochran discloses a mechanism by which the quick coupler assembly 10 connects to an implement such as a bucket 18 whereby

[t]he quick coupler assembly 10 includes an elongated, cross member (not shown) having hitch brackets 26 at its opposite ends with the entire assembly being pivotally attached between loader lift arms 12 by pins 16. Each hitch bracket 26 includes an upper attachment member 28 which is

rotated into a coupling position beneath a respective bucket attachment member 20, as shown in FIG. 4. Further, each hitch bracket 26 includes a lower attachment member 30 which is movable into engagement with the lower inclined bucket ramp 22, as also shown in FIG. 4. (Cochran, col. 3, ll. 40-50.)

5. Upon studying how the bucket connects to the coupler assembly 10 in Cochran (FF4), a person with ordinary skill in the art would know how to adapt the base plate 76 in Egerstrom for connection to the coupler assembly 10 in Cochran.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be

determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.*

The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate the application of this doctrine.” *Id.* at 1739. “In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 1739-40. “*Sakraida* and *Anderson’s-Black Rock* are illustrative – a court must ask whether the

improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 1740.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

ANALYSIS

The rejections are affirmed as to claims 20-22, 24-29, 31-35, and

37-39.

Initially, we note that the Appellants argue claims 20-22, 24-29, 31-35 and 37-39 together as a group, with claims 20, 28 and 35 being the only independent claims in this group. Correspondingly, we select representative claim 20 to decide the appeal of the independent claims, and the remaining independent claims 28 and 35 fall with claim 20. Appellants do not provide a substantive argument as to the separate patentability of claims 21-22, 24-27; and 29, 31-34; and 37-39 that depend from independent claims 20; 28; and 35, respectively. Claims 21, 22, 24-29, 31-35, and 37-39 thus fall with claim 20. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2007).

Appellants assert that the elements of the *prima facie* case of obviousness have not been met by the Examiner, arguing, *inter alia*, deficiencies in the Examiner's findings for (1) motivation or suggestion to combine, (2) reasonable expectation of success, and (3) scope and content of the prior art. (Appeal Br. 5.)

With respect to above element (1) requiring that “[t]here must be some suggestion or motivation... to modify the reference...” (*id.*), this was not a correct statement of the law at the time the brief was filed (*see In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006) (finding that the teaching, motivation, or suggestion may be implicit from the prior art as a whole, and such implicit motivation may come from the knowledge of one of ordinary skill in the art or the nature of the problem to be solved), and it is no longer the law in view of the Supreme Court's recent holding in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). In *KSR*, the Court characterized the teaching, suggestion, motivation test as a “helpful insight” but found that when it is rigidly applied, it is incompatible with the Court's precedents.

KSR, 127 S. Ct. at 1741. The holding in *KSR* makes clear that it is no longer absolutely necessary to find motivation in the references themselves.

Helpful insights, however, need not become rigid and mandatory formulas; and when it is so applied, the TSM test is incompatible with our precedents. The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.

KSR, 127 S. Ct. at 1741.

Appellants argue element (3) above asserting that the rejection made under 35 U.S.C. § 103(a) is improper because “[t]he prior art reference must teach all claim limitations” and Egerstrom does not. (Appeal Br. 5-6.) However, the rejection on appeal is one made under 35 U.S.C. § 103(a) and is based on a combination of references and not Egerstrom alone as Appellants suggest and argue as if a 35 U.S.C. § 102 rejection was at issue. Second, it is undisputed that the combination of Cochran in view of Egerstrom made under 35 U.S.C. § 103(a) describes Appellants’ claimed invention sufficiently to account for all the limitations of claim 1 (FF 1). Appellants only challenge is directed to the deficiencies of Egerstrom singularly, and not to the combination. For example, Appellants argue that “Egerstrom does not provide a base that may be attached to a skid steer.” (Appeal Br. 6.) However, as found *supra* (FF 2) Egerstrom discloses a base plate 76 which merely rests on a turntable mounted on the platform of the vehicle (FF 2), and thus is capable of being removed for whatever reason, including being fitted to another vehicle, such as to the skid steer mount 10 in Cochran. The proposed combination teaches or suggests all claim limitations.

Appellants argue element (2) above and assert the lack of reasonable expectation of success in the proposed combination. Appellants, in support of this challenge, argue that

[T]here would be no reasonable expectation of success, because Egerstrom teaches the permanent mounting of a complicated hose feeding winch to a bed of a large truck, not the quick attachment and detachment of the hose feeding winch to a truck bed or a skid steer. Further, the hose feeding winch has a base that is configured to be attached to a flat surface, namely a bed of a truck. The hose feeding winch base is not designed to be attached to a skid steer on an end thereof.

(Appeal Br. 6.) However, we are not persuaded by Appellants' arguments because, contrary to Appellants' assertions, Egerstrom does not teach the permanent mounting of the hose feeding drum to the bed of the truck, but rather describes that the base plate 76 of the cradle which supports the drum only rests on the turntable 86 on the truck platform (FF 2). As such, the base plate may be removed and can be connected to another type of mounting surface, such as, the coupler assembly 10 in Cochran. Egerstrom's description of the base plate 76 further does not preclude it from being configured for connection to the coupler assembly 10 in Cochran because we find that a person with ordinary skill in the art would know after studying how the bucket connects to the coupler assembly 10 in Cochran, how to adapt the base plate in Egerstrom for connection to the coupler assembly 10 in Cochran (FF 5). *See KSR*, 127 S. Ct. at 1741 ("[A] court can take account of the inferences and creative steps that person of ordinary skill in the art would employ.")

Appellants next argue that “Applicants’ reel does not include a telescoping operated extension unit, but relies on the movement of the skid steer.” (Appeal Br. 7.) However, we find this argument not commensurate with the scope of claim 1 which does not limit the hose reel and the reel frame against having a hose guiding apparatus.

Appellants also argue that

Egerstrom has a width, which is wider than a skid steer; the truck must be backed into an area, unlike a skid steer; and a truck is not capable of traveling over extremely rough terrain as a skid steer. Further, a truck is used for hauling items and a skid steer is used for digging in the ground. Therefore, it would not have been obvious for one skilled in the art to substitute a skid steer for a truck.

(Appeal Br. 7.) This argument is not well taken because Appellants are again attacking Egerstrom individually when the rejection is based on a combination of references. It is the skid steer of Cochran and not the truck of Egerstrom which the Examiner modified to include the hose and reel frames of Egerstrom (FF1). *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58 (CCPA 1968).

Appellants also argue the “Examiner is engaging in hindsight reconstruction by combining the Egerstrom ’093 patent and the Cochran et al. ’720 patent.” (Appeal Br. 7.) In support of this allegation Appellants assert that “[t]he two patents are in two completely different classification areas and do not even have cross referenced fields of search.”

(Appeal Br. 7.) The classification of a device while being some evidence of “analogy” is far outweighed by the similarities and differences in structure and function of the devices found in the prior art. *See In re Ellis*, 476 F.2d

1370, 1372 (CCPA 1973). Here, both devices share similar structures because each is a motorized vehicle which supports a tool for working in an outside environment.

Finally, Appellants assert that since Appellants' device does not use a telescoping extension unit, "Applicants' invention has a lower manufacturing cost than [than *sic*] combining the Cochran et al. skid steer and the Egerstrom hose feeding winch. Cost and ease of manufacturing is a secondary consideration." (Appeal Br. 8.) "In deciding whether or not a claimed invention is obvious, ... the Patent and Trademark Office (PTO) ... must consider objective evidence of nonobviousness-e.g., commercial success." *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996) (citing *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983)). But, "[i]t is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements ...[do] not suffice." *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). Thus, Appellants' assertion or conclusory statement of their lower manufacturing cost does not constitute factual evidence necessary to rebut the Examiner's *prima facie* case.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 20-22, 24-29, 31-35, and 37-39 under 35 U.S.C. § 103(a) Cochran in view of Egerstrom.

DECISION

The decision of the Examiner to reject claims 20-22, 24-29, 31-35, and 37-39 is AFFIRMED.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

hh

Donald J. Ersler
725 Garvens Avenue
Brookfield, WI 53005